

## **REMARKS/ARGUMENTS**

Claims 1-26 are pending. Claims 1-2, 7-10, 15-16 and 25-26 have been rejected under 35 U.S.C. § 102(e) as being anticipated by US Patent 6,633,823 to Bartone et al.

Claims 3-6, 11-14 and 17-24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent 6,633,823 to Bartone et al.

For the reasons set forth below, Applicant respectfully traverses the rejections of the claims.

Claim 26 has been amended to correct the typographical error pointed out by the Examiner.

Included herewith is a Declaration Under C.F.R. Section 131(a) swearing behind the Bartone patent 6,633,823.

The earliest possible effective date of Bartone is July 13, 2000, which is the date that provisional application serial no. 60/218,094 was filed, and which date is claimed by Bartone in application serial no. 09/906,031, filed July 13, 2001, which ultimately matured into US Patent 6,633,823 B2.

Applicant's application serial no. 09/271,104 claims the benefit of its earlier filed provisional application serial no. 60/224,752, filed on August 10, 2000.

The Declaration of the Applicant, Francisco O'Meany, states that the invention claimed in the patent application was conceived prior to July 13, 2000 and that he exercised due diligence in reducing the invention to practice by filing a provisional patent application, as set forth above.

Accordingly, under the provisions of C.F.R. Section 1.131, Bartone is not a reference which can be cited against Applicant's application as a basis for rejection. In view of the fact that both the 102(e) and 103(a) rejections are based solely on the Bartone et al. reference, those rejections must be withdrawn.

Even if the Bartone reference were not eliminated, the claims still would be allowable in that the teachings of Bartone do not anticipate Applicant's invention.

The thrust of the Bartone disclosure is a system that coordinates energy usage with energy availability to reduce energy costs by a user. In performing its function, the Bartone et al. system uses a centralized data center in which energy availability and costs are maintained, along with user profiles. The centralized data center communicates with a transceiver that sends signals to a device controller, which, in turn, sends and receives signals to a power consumption device. This is all best seen in Fig. 1 of Bartone et al.

The device controller 30 receives signals from the centralized data center 22 via facility transceiver 24 and delivers those signals via link 32 to power consumption device 28. The power consumption device 28 can be monitored to send signals via link 32 through device controller 30 and facility transceiver 36 back to the centralized data center via communications network 24.

The device controller 30 is a communication link capable of communicating with power consumption device 28; however, all instructions to power consumption device 28 initiate at the centralized data center 22 and all

data transmitted by power consumption device 28 to device controller 30 is passed on to facility transceiver and the centralized data center. The device controller 30 does not have its own intelligence by which it can detect the conditions at power consumption device 28 and, independent of centralized data center 22, take some action in response thereto.

In Applicant's invention, a master computer 11 initiates a signal which is transmitted to a wireless signal receiver 17. That signal is then made available to intelligent agent 23, which determines if the signal is genuine and authorized and, if so, causes signal generator 27 to issue a shutdown signal to computer 12. The shutdown signal does not result in the interruption of power to the computer 12 from power source 21, but rather initiates a shutdown procedure that the computer must execute prior to power being interrupted. Once the computer has successfully completed its shutdown procedure, it issues a signal via link 19 to intelligent agent 23 via transceiver 27 and then, and only then, does intelligent agent 23 cause the power source 21 to be disconnected from the computer 12 by switch 22.

The clear distinction between the cited art and Applicant's invention is that Applicant's intelligent agent 23 has its own procedures that it executes based on signals it receives from the computer 12 and does not require that computer 11 execute the ultimate shutdown signal. Thus, while in Bartone, all of the intelligence is contained in the centralized data center 22 from which all commands are issued and all data is delivered, in Applicant's invention, data is delivered to and commands are executed from intelligent agent 23

independently of master computer 11.

As regards the 103(a) rejection, Applicant respectfully submits that the Examiner has made an improper “obviousness” conclusion.

In *In re Fritch*, 23 USPQ 2d 1780 (CAFC 1992), the court instructs:

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.” Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious “modification” of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Wilson and Hendrix [Yonekubo and Schulman] fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the Board.

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court had previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”

### **CONCLUSION**

All of the claims in the pending application have been rejected on the basis of Bartone et al., US Patent 6,633,823 B2, which Applicant has sworn behind by his 131 Declaration submitted herewith. Thus, Bartone cannot be cited as a reference. Accordingly, all of the rejections to the claims must be withdrawn.


Applicant has demonstrated that the claims are, in any event, patentable

over Bartone for the reasons given. The 103 rejection is based on an impermissible conclusion of obviousness.

Applicant respectfully requests that the claims now in the case be allowed and a Notice of Allowance issued.

Respectfully submitted,

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# Flow Diagram

